HD)

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,744	10/24/2000	Thomas J. Perkowski	100-046USA000	2224

7590   05/30/2007

Thomas J Perkowski Esq
Thomas J Perkowski Esq P C
Soundview Plaza
1266 East Main Street
Stamford, CT 06902

EXAMINER
CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
05/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/695,744	PERKOWSKI, THOMAS J.
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 March 2007</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>*439-480*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>*439-480*</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>*3/19/07*</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the paper(s) filed 2/28/2007.

Double Patenting

2.   A rejection based on double patenting of the "same invention" type finds its

support in the language of 35 U.S.C. 101 which states that "whoever invents or

discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis

added). Thus, the term "same invention," in this context, means an invention drawn to

identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164

USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in
scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection
based upon 35 U.S.C. 101.

3.   Claims 439-452 are objected to under 37 CFR 1.75 as being a substantial

duplicate of claims 467-480. When two claims in an application are duplicates or else

are so close in content that they both cover the same thing, despite a slight difference in

wording, it is proper after allowing one claim to object to the other as being a substantial

duplicate of the allowed claim. See MPEP § 706.03(k).

4.   Claims 439-450, 453-464, 467-478 of this application conflict with claims 461-496

of Application No. 09/716848. 37 CFR 1.78(b) provides that when two or more

applications filed by the same applicant contain conflicting claims, elimination of such

claims from all but one application may be required in the absence of good and

sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application

or maintain a clear line of demarcation between the applications. See MPEP § 822.

5.   Claims 439-450, 453-464, 467-478 are rejected under 35 U.S.C. 101 as claiming

the same invention as that of claims 461-496 of prior U.S. Patent No. 09/716848. This

is a double patenting rejection.

Claim Objections

Claims 439, 453, 467 are objected to because of the following informalities:

- Claims 439, 453, 467, the plurality of web-based information servers "for
  storing and serving said one or more ..." should be edited to read "for storing
  and configured to serveing said one or more ..." for clarity.

- Claim 453, the second server "for serving a library of tags..." should be edited
  to read "storing and configured to for serveing a library of tags..." for clarity.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

7.   Claims 439-480 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

- ■   Claim 439 includes several instances of "and/or" which render the claim

    scope unclear. It is unclear if the claim minimally requires "and" or minimally

    requires "or".

- ■   Claim 439 states that the apparatus/system claim includes e-commerce

    enabled information servers which is fine. However these servers are also

    stated as "supporting" a plurality of market spaces which is unclear. Is this a

    step of supporting or some additional structural feature? A market space

    appear to the examiner to represent an abstract concept rather than physical

    structure. Keep in mind that applicant may properly impart structure in such a

    claim by claiming an element *configured to* or *programmed to perform*

    function X, etc. When applicant further states that the "market space"

    includes HTML pages, it is unclear if applicant's servers positively

    include/store these HTML pages. Claim 461 states that the HTML pages

    represent products which are offered for sale. It is further unclear what

    structure of applicant's claimed apparatus possesses the capability for

    completing such a sale transaction.

- ■   Claim 439 states that each MMVK is implemented by (i) and (ii). This

    appears to read as a performed method step rather than further defining the

    structure (i.e. capability) of the apparatus. The claim further states that a tag

    is embeddable within any of the HTML pages. It is unclear if applicant is

claiming that the apparatus includes an HTML page and further whether a tag

is positively embedded into that page.

- Claim 439, the end of the claim concludes with a wherein paragraph that

  appears to read as a performed method step rather than further defining the

  structure (i.e. capability) of the apparatus.

- Claim 448 describes the step of how the items are imported in to the network,

  yet the claims are apparatus claims, not method claims. It is not clear what

  applicant is further structurally imitating by this claim.

- Claim 451, this appears to be a step of registration rather than a further

  limitation of applicant's *structure*.

- Claim 452, it is unclear how characteristics of this set of system users can

  define the structure of the system.

- Because claims 453-466 and claims 467-480 appear to be repetition of

  claims, the claims given 112 rejections herein also apply to the associated

  claims repeated within 453-480.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   **Claims 439-480 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Stern (US6591247) in view of Durst, Jr. et al (US6542933).

10.   Regarding claim 439, 441-443, 449, 450, Stern teaches systems and methods

for providing networked, in-store kiosks that can be used to deliver product information

and advertisements. A centralized server (NMC/NOC 12/20) receives various types of

content (ads, information, audio, video, etc) and makes the content available to various

stores [fig 1]. Each store has plural kiosk sites 30 including a video screen, keyboard

and light pen. The kiosks and servers are connected by way of IP protocol and/or the

Internet [4:46-68]. A consumer can scan the UPC barcode (Universal product number

UPN) of a product at the kiosk and receive advertising and other information about the

product [6:46-50, 7:14-17, 27-32, 48-50] which provides a positive brand experience.

Stern teaches that the central database provides a UPC-indexed database of products

that stores the relationship (via the tblUPCmaster table) between the UPC codes and

the associated content (ads, information, audio, etc) associated with that product [8:10-

25]. The UPC codes of Stern are taken to be equivalent to applicant's UPN in that they

both provide an item identifier to be used for database lookups to retrieve and deliver

advertising and item information. Stern teaches that functionality is provided to input

ads/information into the system [6:1-34] which is taken to represent programming of the

various information modes. Stern teaches that a management user interface is

provided for viewing and creating the tables in the database which determine the

content and content delivery mechanisms for the kiosks. It is unclear whether

management workers must interface the system locally or remotely. However, Stern

teaches a distributed system of complex subsystems which communicate over various

networks including the Internet and it would have been obvious to one of ordinary skill at
the time of the invention to have provided the management user interface as a web-
enabled interface (remote GUI) in order for any remotely located manager to access
and program the system. The display of ads and information to the requesting user
about the requested item is taken to provide a virtual kiosk that displays advertisements
and information which are taken to promote the item. Any web page displaying any
content about the requested item is taken to be a "virtual kiosk." Durst, Jr. et al also
teaches a means for a consumer to scan a barcode (at a kiosk [8:1-3]) in order send a
request to a centralized server for more information about the item scanned. Durst, Jr.
et al teaches that the item identification/barcode is scanned into the a web browser and
sent to the server. The server links the user to the URL of the associated information
[3:15-30, 66-67]. Although any advertisement content delivered through an advertising
mode is taken to promote the item advertised, therefore providing a promotion and
promotion mode, Durst, Jr. et al teaches product descriptions as well as product
promotions [col 23 lines 7-29]. It would have been obvious to one of ordinary skill at the
time of the invention to have provided a mode for displaying product promotions as well
Stern's displaying advertising mode and product information mode in order to provide
more brand awareness and encourage the consumer to purchase a particular brand.
Stern does not appear to provide the dynamic web application (UPC-specific
information) with the use of embedded "tags" in the HTML web pages. Durst, Jr. et al
however does teach that a web-based product informaton system can be provided by
use of a Java servlet located at the server [col 6 lines 47-49]. It is taken to be inherent
that provision of a JAVA servlet is accompanied by the necessary <tags> embedded in

the web documents that are to provide the server functionality when the user desires to

interact with the server to obtain the requested information. It would have been obvious

to one of ordinary skill at the time of the invention to have provided access to the

interactive server processes of Stern using embedded tags that point to the proper

JAVA servlets in a manner as taught by Durst, Jr. et al. The ads, promos and CPI

product information provided by the combination are taken to originate from a server(s)

which stores and serves such information. Stern teaches that the site having the kiosk

can also include e-commerce access [5:52].

11.   Regarding claims 440, 444-447, the system of Stern is taken to provide

management with a means (subsystem) for creating the necessary links/indexes/keys of

UPN/TM/PD to the associated content in the databases. Official Notice is taken that

URL links are well known to include icons and/or link text. It would have been obvious

to one of ordinary skill at the time of the invention to have labeled the provided links with

such items in order to describe the link to the user for clarity. Further, Stern teaches

providing ads, audio, video and information about the item. Durst, Jr. et al teaches

providing product and other types of information about products. It would have been

obvious to one of ordinary skill at the time of the invention to have returned a list of URL

links to the user when the product requested is associated with plural content files (ads,

promotions, information, warranty, etc), so that the user may choose which content to

review.

12.   Regarding claim 448, the UPN/TM/PD are taken to be present in the combination

as proposed, however the manner in which the data is introduced or created (whether

through importation or otherwise) cannot be set forth I there is no antecedent basis for system/apparatus claim.

13.   Regarding claims 451, 452, Stern teaches that the site having the kiosk can also include e-commerce access [5:52] which is taken to include registration of the consumer products available for purchase. The parties given access to the system of Stern/Durst are taken to include administrative persons (i.e. not the general public) who are the manufacturers themselves or a representative acting on behalf of the manufacturers.

14.   Claims 453-480 are repetitions of the same concepts as in claims 439-450 and are rejected with the same reasoning.

Response to Arguments

Applicant present new claim language and arguments that focus on a bifurcated approach of providing a server-side component and embedded tag referring to the server-side component. Examiner points to and relies upon the teaching by Durst, Jr. et al to deploy the interactive product look-up system using a JAVA servlet [at least at col 6 lines 47-49] as the basis for the present art rejection.

Applicant argues that that Stern cannot be used in the EC-enabled market space on the WWW. However, Stern teaches that the site having the kiosk can also include e-commerce access [5:52].
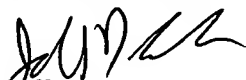
Applicant argues that Durst requires HTTP redirection and requires a special linkage code. Features present in Durst that are not required by the instant claims do not prevent what is disclosed and suggested in Durst from covering the elements in applicant's claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc